

### REMARKS

Independent claim 50 remains in its original form, and independent claim 58 has been amended to correct a typographical error but retains its original scope. Also, dependent claims 51, 57, 59, 60, and 62 have been amended to correct typographical errors. New claims 66-69 have been added. Support for this amendment can be found throughout the original specification. No new matter is added. Claims 50-69 are pending with claims 50, 58, and 66 being independent. Applicant respectfully requests reconsideration of the claims in view of the following remarks.

#### **Claim Objections**

The Office Action (at page 2) objected to claim 58 because of informalities. Specifically, the Office Action noted that the phrase “an adhesive layer coupled to the housing so as to affixed said housing to skin of a user” contains a grammatical error. Applicant has amended claim 58 and requests withdrawal of the objection.

#### **Claim Rejections – 35 U.S.C. §§ 102 and 103**

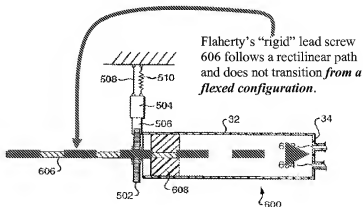
##### Claims 58-65

Independent claim 58 retains its original scope because the proposed ground for rejection was improper. The Office Action (at page 2) rejected independent claim 58 and particular dependent claims under 35 U.S.C. § 102(e) as being anticipated by Flaherty (U.S. Pat. 6,656,159). Applicant respectfully submits that Flaherty fails to teach each and every element of independent claim 58.

First, unlike claim 58, Flaherty fails to teach a medicine dispensing device with an actuation system that includes “*a battery-powered mechanical actuator to move an end portion of the thread member so as to apply a tension force to the thread member and thereby adjust the pivotable body.*” The Office Action (at page 3) contends that the Flaherty’s battery 80 operates as the claimed mechanical actuator. (Flaherty at col. 8, line 47.) Flaherty’s battery 80,

however is not a “mechanical actuator” that physically moves an object such as a thread member. Rather, Flaherty’s battery merely stores potential energy for use by another device (such as an actuator). Indeed, Flaherty’s battery 80 supplies current to shape memory element 508, which then actuates the shape memory element 508 to decrease from an uncharged length to a charged length. Thus, the battery 80 does not act as an “actuator” that physically rotates the wheel 242 (FIG. 7) or moves the slide 504 (FIG. 25). (See Flaherty at col. 11, lines 13-33.) The shape memory element 508, however, does not “move an end portion of [a] thread member.” For at least this reason, the Flaherty reference fails to anticipate claim 58. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983) (“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” (emphasis added)).

Second, unlike claim 58, Flaherty fails to teach a medicine dispensing device with a flexible piston rod “*being movable from a flexed configuration*” in the housing toward a forward longitudinal direction relative to the medicine container to force medicine from the medicine container.” The Office Action (at pages 2 and 6) contends that Flaherty’s lead screw 606 “inherently has some flexibility.” Even if Flaherty’s lead screw 606 was “flexible” (an issue Applicant does not concede), the lead screw 606 does not transition “*from a flexed configuration*” as it is advanced into reservoir 600. Rather, Flaherty’s lead screw 606 is “rigid” and remains rigid as it is “linearly moved” in a rectilinear path to force medicine from reservoir 600. (Flaherty at col. 10, line 47; col. 17, lines 30-33.)



For at least this reason, the § 102(e) rejection based on Flaherty was improper and must be withdrawn.

Third, the Office Action (at pages 2-3) contends that different elements from two different embodiments described by Flaherty should be combined to allegedly teach the recited subject matter. In the context of an anticipation analysis, this is clear legal error. Indeed, “the [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Net MoneyIN v. VeriSign*, 545 F.3d 1359 (2008) (quoting *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972)). *Ex Parte Inoue*, Appeal No. 2003-0946 (Decided Nov. 20, 2003) (“We are persuaded by appellants that the examiner’s finding of anticipation is in error. The rejection appears to be based on picking and choosing elements described in separate embodiments of the reference, without presenting any evidence to show a rationale from the prior art for combining the features in such a way as to meet the terms of the invention that is claimed.”)

In particular, the Office Action contends that the embodiment in Flaherty’s FIG. 7 teaches the claimed pivotable body, but then relies upon an entirely different embodiment (Flaherty’s FIG. 25) for a purported disclosure of the claimed ratchet wheel. The Office Action provides no articulated reasoning as to why the features from two different devices should be combined to achieve the particular device recited in claim 58.

Although FIG. 7 illustrates a “ratchet mechanism 242” (the purported pivotable body) and FIG. 25 illustrates a “gear 502” (the purported ratchet wheel), neither of these embodiments includes both a pivotable body and a ratchet wheel. To the contrary, in Flaherty’s FIG. 7 embodiment, as the ratchet mechanism 242 rotates, pawl 256 engages a gear that is “secured to the lead screw 202.” (Flaherty at col. 12, line 51.) Thus, Flaherty’s gear in FIG. 7 does not have “an inner thread pattern,” as the recited ratchet wheel requires. The Office Action (at page 2) contends that gear 502 teaches the recited “ratchet wheel.” The gear 502 from the embodiment of Flaherty’s FIG. 25, however, does not interact with a “pivotable body,” as recited in claim 58. For at least this reason, the § 102(c) rejection based on Flaherty was improper.

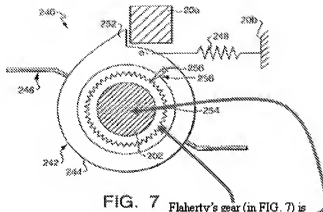


FIG. 7 Flaherty's gear (in FIG. 7) is secured to the lead screw 202 and does not have an inner thread pattern. Indeed, the purported ratchet wheel with an inner thread pattern is from a different embodiment (FIG. 25) that does not include a pivotable body.

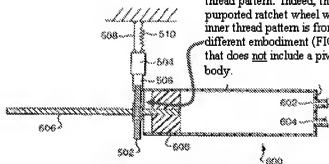


FIG. 25

Even if Flaherty's separate embodiments (FIGS. 7 and 25) could be combined (an issue Applicant does not concede), the combination would fail to teach "*a spring device to bias said pivotable body toward the forward position.*" Indeed, Flaherty's FIG. 7 (and the corresponding text) clearly indicates that rotation of the ratchet mechanism 242 away from the spring causes rotation of the gear and lead screw 202. (See Flaherty at col. 12, lines 16-21 and 60-65.) Thus, the spring 248 biases the ratchet mechanism 242 to a reset position, not toward the forward position as described in claim 58. (*Id.*)

Accordingly, Flaherty fails to teach each and every element of independent claim 58. Applicant respectfully submits that claim 58 is patentable over Flaherty and all other references cited in the record. Dependent claims 59-65 are patentable for at least the same reasons as independent claim 58 and for the additional inventive combinations described therein.

### Claims 50-57

Independent claim 50 remains in its original form because the proposed ground for rejected was improper. The Office Action (at page 2) rejected independent claim 50 and particular dependent claims under 35 U.S.C. § 102(c) as being anticipated by Flaherty. Applicant respectfully submits that Flaherty fails to teach each and every element of independent claim 50.

First, unlike claim 58, Flaherty fails to teach a medicine dispensing device with an actuation system that includes ***"a battery powered actuator coupled to the thread member so as to apply a tension force to the thread and thereby adjust the pivotable body."*** The Office Action (at page 3) contends that the Flaherty's battery 80 operates as the claimed actuator. (Flaherty at col. 8, line 47.) Here again, Flaherty's battery 80 is not an "actuator" that physically moves an object such as a thread member. Rather, Flaherty's battery 80 merely stores potential energy for use by another device (such as an actuator). Indeed, Flaherty's battery 80 supplies current to shape memory element 508, which then actuates the shape memory element 508 to decrease from an uncharged length to a charged length. Thus, the battery 80 does not acts as an "actuator" that physically rotates the wheel 242 (FIG. 7) or moves the slide 504 (FIG. 25). (See Flaherty at col. 11, lines 13-33.) For at least this reason, the Flaherty reference fails to anticipate claim 58. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983) ("Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." (emphasis added)).

Second, the Office Action (at pages 2-3) contends that different elements from two different embodiments described by Flaherty should be combined to allegedly teach the recited subject matter. As previously described, this is clear legal error in the context of an anticipation analysis. *Ex Parte Inoue*, Appeal No. 2003-0946 (Decided Nov. 20, 2003) ("We are persuaded by appellants that the examiner's finding of anticipation is in error. The rejection appears to be based on picking and choosing elements described in separate embodiments of the reference,

without presenting any evidence to show a rationale from the prior art for combining the features in such a way as to meet the terms of the invention that is claimed.”)

As previously described, the Office Action contends that the embodiment in Flaherty's FIG. 7 teaches the claimed pivotable body, but then relies upon an entirely different embodiment (Flaherty's FIG. 25) for a purported disclosure of the claimed ratchet wheel. The Office Action provides no articulated reasoning as to why the features from two different devices should be combined to achieve the particular device as recited in claim 58.

Although FIG. 7 illustrates a “ratchet mechanism 242” (the purported pivotable body) and FIG. 25 illustrates a “gear 502” (the purported ratchet wheel), neither of these embodiments includes both a pivotable body and a ratchet wheel. To the contrary, in Flaherty's FIG. 7 embodiment, as the ratchet mechanism 242 rotates, pawl 256 engages a gear that is “secured to the lead screw 202.” (Flaherty at col. 12, line 51.) Thus, Flaherty's gear in FIG. 7 does not have “an inner thread pattern,” as the recited ratchet wheel requires. The Office Action (at page 2) contends that gear 502 teaches the recited “ratchet wheel.” The gear 502 from the embodiment of Flaherty's FIG. 25, however, does not interact with a “pivotable body,” as recited in claim 58. For at least this reason, the § 102(e) rejection based on Flaherty was improper.

Accordingly, Flaherty fails to teach each and every element of independent claim 50. Applicant respectfully submits that claim 50 is patentable over Flaherty and all other references cited in the record. Dependent claims 51-57 are patentable for at least the same reasons as independent claim 50 and for the additional inventive combinations described therein.

#### Claims 66-69

Independent claim 66 describes subject matter that is also patentable over Flaherty and all other references cited in the record. Indeed, the Flaherty reference fails to disclose a number of features recited in claim 66. In one example, Flaherty fails to teach a medicine dispensing device with an actuation system that includes “a battery-powered mechanical actuator to move an end portion of the thread member so as to apply a tension force to the thread member and thereby adjust the pivotable body.” Applicant respectfully submits that claim 66 is patentable over

Flaherty and all other references cited in the record. Dependent claims 67-69 are patentable for at least the same reasons as independent claim 66 and for the additional inventive combinations described therein.

### **Request for Reconsideration**

Applicant submits that claims 50-69 are patentable over the prior art of record. Reconsideration and allowance is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper. Applicant hereby specifically reserves the right to prosecute claims of different or broader scope in a continuing application. The Patent Office should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Office Action, based on the amendments made herein.

No fees are believed to be due. If necessary, please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: November 4, 2009

/Michael T. Hawkins/

Michael T. Hawkins

Reg. No. 57,867

Fish & Richardson P.C.  
3200 RBC Plaza  
60 South Sixth Street  
Minneapolis, Minnesota 55402  
Telephone: (612) 335-5070  
Facsimile: (877) 769-7945